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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,990	08/28/2002	Jurgen Lang	ACDPA-5002 PWO	3252
23416	7590	08/10/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			FIELDS, COURTNEY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/089,990	Applicant(s) LANG ET AL.	
	Examiner Courtney D. Fields	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02 April 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 have been amended.
2. Claims 18-27 have been added.
3. Claims 1-27 are pending.

Information Disclosure Statement

4. The Information Disclosure Statement respectfully submitted on 02 April 2002 has been considered by the Examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 22 provides for the use of the security module of claim 18, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-21 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Micali (U.S. Patent No. 5,537,475).

Referring to the rejection of claims 1,8, and 26, Micali discloses a system and method for securing communication within a network by using highly-secure digital signatures. The system comprises a data input port via which information is input into the secure system (security module) (See Column 4, lines 51-67)

a first combination machine including first means for generating and transferring a first result value via a first data port to an authentication unit (See Column 5, lines 1-11)

and a second combination machine including a second means for generating and transferring a second result value via a second data output port to document to be issued (See Column 5, lines 1-11)

wherein the second result is independent of any information in the document to be issued (see Column 7, lines 50-64)

Referring to claim 2, Micali discloses the claimed limitation wherein a secret generator generates an unpredictable secret (See Column 3, lines 66-67, Column 4, lines 1-15)

Referring to claim 3, Micali discloses the claimed limitation wherein the secret generator is connected to at least one of the first combination machine and to the second combination machine in such a way that the unpredictable secret generated by the secret generator is introduced into one or more of the first combination machine and into the second combination machine (See Column 4, lines 16-35)

Referring to claim 4, Micali discloses the claimed limitation wherein an identification register has an output value of the identification register provided to the first combination machine in such a manner that a value of the identification register is introduced into a data combination issued by the first combination machine (See Column 4, lines 39-43)

Referring to claim 5, Micali discloses the claimed limitation wherein at least one encryption machine that encrypts an output value of one of the first and second combination machines (See Column 6, lines 30-35)

Referring to claim 6 and 27, Micali discloses the claimed limitation wherein at least one value contained in the key register is used by the encryption machine for encryption purposes (See Column 6, lines 46-48)

Referring to claim 7, Micali discloses the claimed limitation wherein comprising a hash machine (See Column 3, lines 66-67, Column 4, lines 1-5)

Referring to claim 9, Micali discloses the claimed limitation wherein the secret is outputting the further processed secret via a first data output port and outputting data acquired from the combination of data representing the secret and the input data at a second data output port (See Column 4, lines 36-50)

Referring to claims 10 and 19, Micali discloses the claimed limitation wherein combining data representing the secret and the input data (See Column 4, lines 55-67)

Referring to claim 11, Micali discloses the claimed limitation wherein irreversibly linking data representing the secret and the input data to each other (See Column 7, lines 25-35)

Referring to claims 12 and 18, Micali discloses the claimed limitation wherein linking the data representing the secret while introducing data of an identification register (See Column 7, lines 20-24)

Referring to claim 13, Micali discloses the claimed limitation wherein encrypting a result of a combination of the data representing the secret and data of the identification register (See Column 4, lines 55-67)

Referring to claim 14, Micali discloses the claimed limitation wherein simultaneously carrying out the encrypting while introducing a key whose value is stored in a key register (See Column 5, lines 12-25)

Referring to claim 15, Micali discloses the claimed limitation wherein transferring data that is output from the first data output port to an authentication unit (See Column 4, lines 36-45)

Referring to claim 16, Micali discloses the claimed limitation wherein linking through the authentication unit, the transferred data with another key (See Column 4, lines 53-67)

Referring to claim 17, Micali discloses the claimed limitation wherein the step of outputting data at the second output port comprises outputting forgery-proof information to the forgery-proof documents to be issued (See Column 6, lines 20-32)

Referring to the rejection of claims 20,23, and 25, Micali discloses system and method for producing forgery-proof documents comprising:

an identification register (See Column 4, lines 36-50), a key register (See Column 4, lines 6-15) and a secret generator that generates an unpredictable secret (See Column 7, lines 1-11)

a first combination machine that combines an output of the identification register and an output of the secret generator (See Column 5, lines 1-11)

an encryption machine that encrypts an output of the first combination machine (See Column 6, lines 30-35)

a first outlet valve that outputs an encrypted output of the encryption machine via

an authentication unit (See Column 4, lines 36-45)

a second combination machine that combines the unpredictable secret and input data received via an inlet valve (See Column 5, lines 1-11)

a hash machine that generates an irreversible hash value responsive to an output of the second combination machine (See Column 3, lines 66-67, Column 4, lines 1-5)

and a second outlet valve that outputs the hash value, wherein the hash value is independent of contents of the forgery proof document (See Column 6, lines 20-32)

Referring to claim 24, Micali discloses the claimed limitation wherein the outputting the hash value to the forgery-proof document (See Column 7, lines 1-6)

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cdf

August 6, 2006



EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER